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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/746,611
Filing Date: December 21, 2000
Appellant(s): PERRY ET AL.

MAILED

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GROUP 3600

Thad Perry et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 25, 2007 (with replacement Summary section filed July 9, 2007) appealing from the Office action mailed November 24, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Rejection of claims 1, 3, 4, 7, 8, 12-18, 22-26, and 28-58 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,957,191 to Belcsak et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, 8, 12-18, 22-26, and 28-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belcsak et al. (U.S. Pat. No. 6,957,191; *herein* "Belcsak").

As per claim 1, Belcsak discloses a method of preparing and evaluating a business proposal, comprising the steps of:

displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment (col. 2, lines 7-11; col. 3, lines 19-24; col. 7, lines 47-57; items 30, 32 and 34 in Figure 2: Users use an interactive interface, such as a CAD interface, to manipulate displayed data to generate contents of a proposal, where the displayed data includes the financial structure of the proposal, flows of money and assets, parties involved, and various scenarios for the proposal.);

allowing access to a database of client information and a database of proposer information (col. 30, lines 12-42; col. 33, lines 23-30; col. 35, lines 6-19: The database maintains all parameters essential to the proposal generation and analysis, where the parameters identify everything from party involved to cash classification.);

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receiving answers to the plurality of questions based on information accessed in the databases (col. 6, lines 49-55; col. 8, lines 13-27: The engine receives input from a user, where the input answers questions relating to all the aspects of a proposal.);

defining a query for search criteria for the proposal and performing a search based on the query and answers to the questions (col. 14, lines 37-53; col. 14, line 66- col. 15, line 27; col. 24, lines 30-33; col. 32, lines 32-49: The optimization engine allows user to define a search query by inputting objectives and constraints for the proposal. The optimization engine then applies the inputs to an optimization model and outputs the results to the user.);

storing information relevant to the proposal gathered in the search (col. 15, lines 40-41; col. 21, lines 53-60: Data including decision variables and parameter constraints for each structure and outcome is saved.);

selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership and a venture (col. 7, lines 6-9 and 29-35; col. 10, lines 14-36; col. 11, lines 59-62: Users may view alternative financial structures and manipulate decision variables to change the outcomes for the structures.);

evaluating the stored information by computer (col. 21, lines 43-52: showing an example in which two alternative outcomes are evaluated.); and

reevaluating information sources and a business environment relative to the proposal and reevaluating organizational and proposal considerations, and risks relative to the proposal; reconsidering at least one of the alternative structures and optionally

reshaping at least one of the alternative structures; and reevaluating the at least two alternative structures (col. 3, lines 60-64; col. 4, lines 10-15 and 24-37; col. 8, lines 27-50; Figure 2: The user may interact with the optimization engine and add/modify different scenario parameters and constraints for reevaluation.).

While Belcsak discloses evaluating two alternative structures to optimize the proposal based on certain parameters and constraints and displaying the results of the optimization (col. 3, lines 10-34; col. 4, lines 24-37; col. 24, lines 30-58; col. 25, lines 2-13), Belcsak does not expressly disclose *ranking the two alternative structures based on the evaluation of the stored information and displaying the rankings*.

Belcsak teaches an optimization engine which evaluates parameters and constraints associated with structures and then optimizes the structures based on the user's goals and constraints. The optimization engine, in essence, must perform some type of internal ranking in order to determine which structures provide the best deal to the user. Additionally, it is old and well known to display rankings to a user who is making a decision based on the rankings as visual rankings provide the benefit to the user of an easily quantifiable analysis. Belcsak is expressly directed to benefit a user who is making a decision based on alternative scenarios, and thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to have the optimization engine of Belcsak also display rankings of the alternative structures after it performs its internal optimization based upon the user's indicated goals, thereby providing the user with a visual indication with which to easily discern which scenarios is optimal for the user.

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As per claim 3, Belcsak teaches or suggests the method of claim 1 as above, and further wherein the step of displaying a plurality of questions comprises displaying predetermined questions on at least one template stored in a computer and wherein the step of receiving the answers to at least one predetermined question calls up for display at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 8, lines 13-27; col. 12, lines 29-34; col. 16, lines 50-58: Stored templates, or canned instruments, are activated when the user indicates that the proposal will include a particular financial instrument or transaction, where the canned instruments include a set of required inputs/calculations related to the particular instrument or transaction that the user must provide.).

As per claim 4, Belcsak teaches or suggests the method of claim 1 as above, and further wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (col. 8, lines 2-6).

As per claims 7 and 15-17, Belcsak teaches or suggests the method of claim 1 as above, and further comprising displaying the rankings with a graphical user interface or that the ranking includes numbers, the analysis of which is provided above in claim 1 (a "visual indication" of rankings is a ranking that includes numbers or where rankings are indicated graphically).

As per claim 8, Belcsak teaches or suggests claim 7; however, Belcsak does not expressly disclose *wherein the rankings are presented in a Harvey-ball format*.

Official notice is taken that the Harvey-ball format is an old and well-known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view and compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art for Belcsak to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 12 and 13, Belcsak teaches or suggests the method of claim 1 as above, and further wherein the answers are input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box (Figures 5-12 and 14-23).

As per claim 14, Belcsak teaches or suggests the method of claim 1 as above, and further wherein the proposal comprises an offer of a service from the provider, and further comprising the step of calculating a way to pay for the proposal (col. 7, lines 6-9 and 29-35; col. 9, lines 30-34; col. 19, lines 22-49: An example of leasing a plane is provided in which the lessee has the option to buy the plane. Rental agreements are another example of providing a service and determining how payment will occur.).

As per claim 39, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein the alternative structures between the purchaser and the provider differ in an amount of equity owned by the purchaser and the provider (col. 19, lines 1-36: An example discusses scenarios that compare when a lessor owns the equipment versus when the lessee owns the equipment.).

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As per claim 40, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein an advantage of at least one of the structures is creation of an asset (col. 19, lines 1-36: When the ownership of equipment transfers to a party, that is a creation of an asset to that party.).

As per claim 41, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures (col. 14, line 64-col. 15, line 6; col. 19, lines 1-36: The agreement regarding transferring ownership of equipment includes buyout parameters as well as tax implications, thus demonstrating different values to each party.).

As per claim 42, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures (col. 14, line 64-col. 15, line 6).

As per claim 43, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein the values of the at least two alternative structures are calculated as revenue streams to the purchaser (col. 24, lines 39-42).

As per claim 44, Belcsak teaches or suggests the method of Claim 1 as above, and further wherein the values of the at least two structures are calculated as at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (col. 8, lines 2-6).

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Claims 18, 22-26, 28-38, 45-58 recite methods and systems performing substantially the methods of claims 1,3, 4, 7, 8, 12-17 and 39-44 above, and are similarly rejected for reasons given above for the respective claim and claim elements.

(10) Response to Argument

With respect to claim 1, Appellant argues Belcsak does not teach or suggest *selecting and ranking at least two proposals selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture* (Brief, page 4), and additionally, that failing to teach or suggest the ranking of alternative structures, it could not be obvious to one of ordinary skill to modify Belcsak to *output a report displaying the rankings* (Brief, page 9, bottom).

With respect to claims 18 and 32, Appellant similarly argues Belcsak does not teach or suggest *selecting at least two alternative structures...selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture* (Brief, page 9); or *calculating an advantage of the structures* (claim 18) or *calculating and generating an output* (claim 32), limitations asserted by Appellant as corresponding to *selecting and ranking of alternative structures* (Brief at page 9). Examiner notes that claims 18 and 32 do not recite *selecting* or *ranking* steps, however, for the purposes of argument, the step of *proposing at least two alternatives* and *calculating an advantage* (claim 18) and the element of *calculating and generating an output* (claim 32) will be read as at least suggesting such steps.

Appellant's essential points in support of arguments above over Belcsak are as follows:

- a) that modeling a financial structure does not encompass selecting a business structure;
- b) that optimizing financial alternatives is not the same as ranking business structures, and
- c) that providing visual rankings is not obvious if Belcsak does not disclose rankings. (Brief at page 10)

With respect to a) above, Appellant characterizes Belcsak as a tool that performs calculations for finance operations involved in a merger or acquisition, which, in being limited to the modeling and analysis of financial structures, does not anticipate "business structures." (Brief at page 4). While Appellant acknowledges that "Belcsak gives examples showing a tool and interface designed to receive and implement different types of information to create a model of a financial structure" (Brief at page 5), Appellant asserts that providing a financial structure is not the same as providing a business structure.

Examiner respectfully disagrees: The disclosure of the present invention does not explicitly define "business structure," however numerous references to "structure(s)" in the specification suggest a broadest reasonable interpretation of a "business structure" as encompassing a financial structure as defined and employed in Belcsak.

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The term “structure” is used in numerous passages in the specification of the present invention, including:

“...a computerized process is used to structure the proposal” (page 1 at line 9);

“... the information, especially financial information, is input into a computer, along with one or more proposed structures for the proposal” (page 3 at line 23);

“Structures for the proposal may include any form of business entity or enterprise” (page 2 at line 28).

“Depending on the structure of the business, a return for stockholders in terms of dividends along with an estimate of capital appreciation may also be calculated” (page 18 at line 7); and

...the deals or proposals may be examined from several viewpoints, or structures, to determine whether any of them may be advantageous to one party or another (page 3 at line 12).

Thus, alternative definitions and use of the term “structure” in the disclosure encompass “any form of enterprise” or “viewpoints” by which deals may be examined, and further, in such structures emphasis is placed on the *financial* aspects of such deals. Similarly, Belcsak discloses creating financial structures and using financial information to evaluate profitability of financial deals with the express purpose of allowing the user to find the best financial structure among multiple scenarios, or viewpoints, for one or the other party to the deal.

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Focusing solely on the claims at issue reciting *alternative structures... selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture*:

An alliance is an association between two parties to further their common interests and a partnership is a legal relationship existing between persons or entities contractually associated (Webster's Online). By example, Belcsak discloses the modeling and evaluation of a lessor/lessee (two parties) entering into a financial association involving the lease (a legal relationship) of Telecommunications Equipment (see page 10 from ¶ [0135]).

Accordingly, under a broadest reasonable interpretation of "structure" in the claims given its definitions and the term's use in the specification and claims, Belcsak fairly teaches *proposals selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture*. Nothing in the claims at issue limits "structures" to "business structures" in terms which preclude financial structures from meeting the metes and bounds of "structures" as presently claimed.

With respect to b) above, Belcsak teaches an optimization engine which evaluates parameters and constraints associated with each financial structure created by the user, optimizes the structure based on the user's goals, and allows the user to refine the structure, adding or deleting financial instruments and adjusting other parameters. Upon each change in financial structure, the optimization engine performs an optimization to maximize profitability of the deal; that is, the optimization engine

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produces a numerical dollar *ranking* of the “bottom line” profitability of the financial structure as proposed. With each optimization, the user also performs a “ranking” of the outcomes in selecting (and further refining) one financial structure over another based on the results of the optimization. Nothing in the claims as recited with respect to *selecting and ranking* precludes the selecting and ranking from being performed serially for successive financial structures.

With respect to c) above, Belcsak was not alone used to teach providing visual rankings; rather, it was asserted as old and well known to display (visually) to a user who is making a decision the rankings of alternative solutions to provide the user the benefit of an easily quantifiable analysis. Therefore, it is asserted, if Belcsak teaches or suggests ranking of alternatives, then it would be obvious to one of ordinary skill to provide *visual rankings* of the outcomes of optimizations for the alternative financial structures.

For at least the reasons given above with respect to claim 1, Belcsak teaches or suggests *selecting and ranking at least two proposals selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture*, and additionally, *outputting a report displaying the rankings*.

For at least the reasons given above with respect to claims 18 and 32, to the extent that the claims can be interpreted as having *selecting and ranking* steps, Belcsak

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teaches or suggests *selecting at least two alternative structures...selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture, and calculating an advantage of the structures or calculating and generating an output.*

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dave Robertson

Examiner

Art Unit 3623

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